

REMARKS

This is responsive to the Office Action dated May 7, 2001. Claim 5 has been amended by further defining the insulating member as being a single, one-piece element. No new matter has been added.

Claims 5-8 stand rejected under 35 U.S.C. §251 as being an improper recapture of claimed subject matter deliberately cancelled in the application for the patent upon which the reissue is based. The Examiner argues that "narrow scope of the claims in the patent was not in error within the meaning of 35 U.S.C. §255 and that the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application". It is respectfully submitted that this argument is not well taken.

Initially, it is noted that the Examiner's citation from *Ball Corporation v. United States*¹ does not constitute the opinion of the Federal Circuit. Rather, it is a restatement of the opinion of the Court of Claims in *Haliczer v. United States*, a case on which the government very heavily relied on in *Ball Corporation*. Id. At 294, 295.

In the very next sentence the CAFC clarifies:

On the other hand, the patentee is free to acquire, through reissue claims that are *narrower* in scope than the cancelled claims. Id. at 295.

In the instant application, the claims presented for reissue are **narrower** in scope than the **cancelled** claims. In fact, reissue claim 5 is substantially identical to independent claim 21 except that the following limitations have been added which, *in toto*, renders the reissue claim **narrower** in scope than cancelled claim 21:

¹ "The recapture rule bars the patentee from acquiring through the reissue, claims that are of the same or broader scope than those claims that were cancelled from the original application". *Ball*

Cancelled claim 21 did not contain the following limitations which are present in the reissue claim:

- The insulating member is only in axial contact with the radially extending surface of the membrane spring and
- The insulating member is a single, one-piece element; and extends circumferentially about the pressure plate.

Thus, reissue claim 5 is **narrower** than cancelled claim 21. See *In re Wadlinger*, 181 USPQ 826, 830 (CCPA 1974); *In re Petrow*, 159 USPQ 449, 451 (CCPA 1968); *In re Willingham*, 127 USPQ 211 (CCPA 1960); *Mentor Corp. v. Colorplast Inc.*, 27 USPQ 2d 1521, 1525 (Fed. Cir. 1993) ("Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule."); *In re Clement*, 45 USPQ 2d 1161, 1165 (Fed. Cir. 1997).

There is no question that the scope of reissue claim 5 is narrower than the scope of cancelled claim 21. Under these circumstances, the recapture rule does not apply at all. *Clement*, 45 USPQ 2d at 1165 ("In contrast, a reissue claim narrower in scope escapes the recapture rule entirely").

According to the analysis set forth in *In re Clement*, the first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claims are broader than the patent claims. Here, the reissue claims are broader and narrower in regard to an aspect (the definition of the insulating member) that directly relates to the rejections of the original claims. The fact that the claims are broader is no issue since reissue was sought within the two year statutory period. On the other hand, the fact that the reissue claims are narrower in an aspect that

Corporation v. United States, 221 USPQ 289, 295 (Fed. Cir. 1984).

directly relates to the rejection of the cancelled claims, renders the recapture doctrine inapplicable in this case. In other words, the fact that the reissue claims are broader than the patent claims only means that reissue must be sought within two years after grant of the original patent. It certainly does not mean, as the Examiner alleges, that reissue claims that are broader in scope than the patent claims can never be obtained. *Mentor* at 1525 ("Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule.") Accordingly, the Examiner's argument that the deliberate cancellation of claims in the original patent was not an error within the meaning of 35 U.S.C. §251 has been flatly rejected by the CAFC in *Ball Corporation*.

The second step of the analysis, according to *Clement*, is to determine whether the applicant **surrendered** particular subject matter when the original claims were cancelled. In this connection, the Federal Circuit has clearly stated that the recapture rule does not apply in the absence of evidence that applicant's amendment was "an admission that the scope of that claim was not in fact patentable." *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 221 USPQ 568, 574 (Fed. Cir. 1984). There is nothing in the file history which would support the Examiner's allegation that applicant intentionally surrendered certain subject matter. To the contrary, as pointed out above, when applicant's attorney elected allowable subject matter he stated that "**Applicant retains the right to pursue broader claims under 35 U.S.C. §120**" (amendment dated September 29, 1997, at page 16, paper 16).

In light of the position by the Federal Circuit that deliberate cancellation of claims does not amount to an admission that reissue claims were not patentable at the time the original claims were cancelled, it is clear that no conclusion as to the patentee's intent and, therefore, as to the absence of "error" within the meaning of the 35 U.S.C. §251 can be made. *Patecell v. U.S.*,

12 USPQ 2d 1440, 1447 (U.S. Cl. Ct. 1989) ("This court concludes that the recapture rule should not bar a patentee from securing a reissue claim that is broader in a material respect than a cancelled claim when, as is potentially the case here, the reissue claim also is narrower than the cancelled claim in a way that is material to the error.") Accordingly, applicant's attorney's error is a proper basis to satisfy the "error" requirement of 35 U.S.C. §251. *Clement* at 1164 ("An attorney's failure to appreciate the full scope of the invention qualifies as an error under Section 251 and is correctable by reissue.") The rejection of claims 5-8 under 35 U.S.C. §251 should be withdrawn and the same is hereby respectfully urged.

Turning now to the art rejections, claims 5, 6 and 8² stand rejected under 35 U.S.C. §§102(a) and (e) as being anticipated by Hayes U.S. Patent No. 5,499,704 (Hayes). The rejection is respectfully traversed. Claim 5 as amended now clearly recites that the insulating member is a single, one-piece element so that the Examiner's construction of Hayes, i.e. that the balls 44 and the retainer ring 56 together are considered to be the insulating member no longer applies.

The reissue claims recite that the insulating member is "a single, one-piece element" and that the insulating member "is only in axial contact with said radially extending surface of said membrane spring". In stark contrast, the ball retainer ring 56 in Hayes does not contact the diaphragm spring 30. On the other hand, and although spherical balls 44 are in contact with diaphragm spring 30, they do not extend "circumferentially about said pressure plate" (considering the single, one-piece construction of the insulating member) as now claimed

² There appears to be no rejection of claim 7. Thus, claim 7 should be allowable over the prior art.

by applicant. Accordingly, the friction clutch disclosed by Hayes, with its spherical balls 44 does not read on applicant's reissue claims.

In addition, the claims require that the insulating member is in axial contact with the membrane spring, which is not the case with a molded plastic portion of Hayes (ball retainer ring 56). Thus, the ball retainer ring 56 cannot be part of the thermal insulating member as is now recited in applicant's reissue claims. The thermal insulating member in Hayes can only be the spherical balls 44. Hence, Hayes fails to disclose that the insulating member as a first resistance to the thermal conductivity and the membrane spring has a second resistance to thermal conductivity and that the first resistance to thermal conductivity is higher than said second resistance, as is recited in applicant's reissue claims. Based on the preceding arguments, it is respectfully submitted that the rejection under 35 U.S.C. §102 as anticipated by Hayes should be withdrawn.

With respect to claim 6, applicant's claim requires the insulating member to be in axial contact with the membrane spring. In Hayes, spherical balls 44 are in contact with the membrane spring but the balls 44 do not comprise a second surface contacting the pressure plate as is recited in claim 6. In Hayes, although the ball retainer ring 56 (which, for the reasons set forth above, cannot be the insulating member recited by applicant) is in contact with pressure plate 16, the ball retainer ring 56 is not in contact with the membrane spring as recited in claim 6. Accordingly, the rejection of claims 5 and 6 based on Hayes should be withdrawn and the same is hereby respectfully urged.

Claim 8 is directed to the embodiment shown in Fig. 3, i.e. a friction clutch wherein the insulating member 5 is disposed between a first and second portion of the pressure plate as recited in claim 8 ("said pressure plate comprises a first portion and a second portion").

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Accordingly, the rejection of claim 8 as anticipated by Hayes should be withdrawn and the same is hereby respectfully solicited.

A Notice of Appeal is filed concurrently herewith.

It is believed that no fees or charges are required at this time in connection with the present application; however, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

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AMENDMENTS TO THE CLAIMS SHOWING CHANGES

In the Claims:

Claim 5. (Amended) A single disc friction clutch for a motor vehicle, comprising:

a clutch housing;

a single clutch disc being configured to be mounted on a transmission input shaft

having a longitudinal axis;

said single clutch disc being configured to be axially movable along the

longitudinal axis of a transmission input shaft;

a solid pressure plate having a surface;

at least one friction lining mounted on said clutch disc; said at least one friction lining being configured to be disposed between said pressure plate and a flywheel;

said pressure plate being configured and disposed to engage and disengage said clutch disc with a flywheel; said pressure plate being configured and disposed to be axially movable along the longitudinal axis of a transmission input shaft;

a membrane spring; said membrane spring being disposed between said clutch housing and said pressure plate and having on one axial side a radially extending surface facing said pressure plate;

said membrane spring being configured and disposed to bias said pressure plate;

a thermal insulating member supported on said surface of said pressure plate and disposed between said pressure plate and said membrane spring so that the insulating member is only in axial contact with said radially extending surface of said membrane spring;

said thermal insulating member being configured to minimize the contact between said thermal insulating member and said membrane spring;

said insulating member being a single, one-piece element and extending circumferentially about said pressure plate and having a first resistance to thermal conductivity and said membrane spring has a second resistance to thermal conductivity, and wherein said first resistance to thermal conductivity is higher than said second resistance;

said thermal insulating member being rigid and comprising a metal;

said metal of said insulating member being configured to minimize heat conduction from said pressure plate to said membrane spring.